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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

24267 7590 06/27/2003
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EXAMINER

LUU, SY D

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 06/27/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,134

Applicant(s)

HEDLOY, ATLE

Examiner

Sy D Luu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This communication is responsive to Amendment C, filed 4/26/03.
2. Claims 1-18 are pending in this application. Claims 1, and 14 are independent claims. In the Amendment C, claims 2 and 8 were amended. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso (U.S. patent 6,085,201) in view of Pandit (U.S. patent 5,859,636).

As per claim 1, Tso teach a method of information handling within a document created using a first application, such as an e-mail application 20, at figure 2, comprising the steps of: entering a first information in the first application program, at column 4, lines 32 35; and responding to a user selection by inserting a second information into the document, the second information associated with the first information from a second application program, such as template engine 5, at column 6, line 66 to column 7, line 2.

Tso teaches the above steps of claim 1, but does not specifically teach automatically marking the first information to alert the user that the information can be used in a second application.

On the other hand, it is known in the art that information can be marked so that a user is informed of its possible use in other applications. For instance, Pandit teaches "recognition of

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text in a body of text as belonging to a predetermined class and performing an operation relevant to the recognized text" at column 1, lines 51-53. Pandit also teaches marked information, with highlighted text 11, 14, 16, at figures 1a-1f, and column 2, lines 5-6, 51, 64-65. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the accented text of Pandit in the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

As to claim 2, Tso teaches a user interface device, at column 3, lines 34-35.

As per claim 3, Tso teaches the following: initializing the second application, at column 4, lines 48-51; searching, using the second application, for the second information associated with the first information, at column 5, lines 7-17; and retrieving the second information, at column 5, lines 42-48.

Tso also teaches displaying the second information [claim 4] at column 5, lines 42-44, and completing the first or second information [claim 5] at column 6, lines 6-10.

Regarding claim 6, Pandit teaches name information, at column 7, line 43.

As to claims 7 and 9-13, Tso teaches a computer readable medium, at column 8, lines 2-4.

Regarding claim 8, Pandit teaches computer data signals embodied in a carrier wave, the computer data signals carrying information over a network, at column 5, lines 38-43.

As to claim 14, Tso teaches the following subject matter: entering a first information in the first application program, at column 4, lines 32-35; and responding to a user selection by performing an operation related to a second information, the second information associated with

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the first information from a second application program, such as template engine 5, at column 6, line 66 to column 7, line 2, and column 7, lines 14-25.

Tso teaches the above steps of claim 14, but does not specifically teach automatically marking the first information to alert the user that the information can be used in a second application.

On the other hand, it is known in the art that information can be marked so that a user is informed of its possible use in other applications. For instance, Pandit teaches "recognition of text in a body of text as belonging to a predetermined class and performing an operation relevant to the recognized text" at column 1, lines 51-53. Pandit also teaches marked information, with highlighted text 11, 14, 16, at figures 1 a1f, and column 2, lines 5-6, 51, 64-65.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the accented text of Pandit in the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

As to claim 15, Pandit teaches name information, at column 7, line 43, and operations selected from a group consisting of an e-mail, a telex, a fax, or a letter, at column 2, lines 39-41, 58-59, and column 2, line 67 to column 3, line 8.

Tso further teaches entering additional data into a database [claim 16] at column 7, line 19, which is entered by a user [claim 17] at column 7, lines 14-25, and located within a document [claim 18] at column 6, lines 6-10, and figure 4.

Response to Arguments

5. Applicant's arguments with respect to claims 1-18 have been fully considered but they are not persuasive.

Applicant argues that whereas Applicants claimed invention automatically marks the text without user intervention, Pandit's highlighting of text requires the user to manually highlight or select the text.

The Examiner disagrees for the following reasons: the claim language, as recited in claim 1, does not require the marking to be performed "without user intervention". It is noted that an application program always perform an operation automatically whether the operation is initiated by the system or by the user. For example, in Pandit's method, the step of highlighting is done by the system automatically once the user points to the text. That is, the user does not have to instruct the system to specifically perform the step of highlighting in order for the highlighting to happen, but rather the user only has to point to the text for the highlighting to happen. Therefore, the difference between the methods of Applicant and Pandit is for the marking step to happen "without user intervention" as argued by Applicant. If that is what Applicant intends the claimed invention to be, Applicant is invited to incorporate the limitation of "without user intervention" into the independent claims in order to distinguish over the Pandit reference.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquires

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(703) 305-0409**. The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

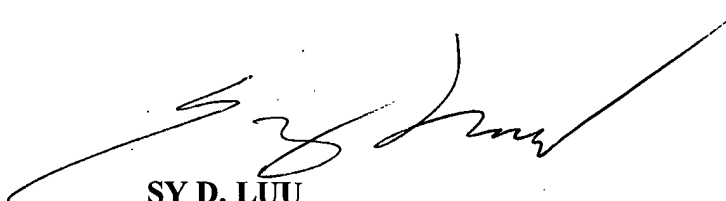
The fax number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



**SY D. LUU
PRIMARY EXAMINER**